

ESTTA Tracking number: **ESTTA716312**

Filing date: **12/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060464
Party	Defendant Cheytac USA LLC
Correspondence Address	MILO S COGAN FISHERBROYLES LLP 4140 ROSWELL ROAD ATLANTA, GA 30342 UNITED STATES milo.cogan@fisherbroyles.com
Submission	Opposition/Response to Motion
Filer's Name	Milo S. Cogan
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Signature	/s/Milo S. Cogan
Date	12/22/2015
Attachments	Response to MSJ FINAL.pdf(641239 bytes) Exhibit A.pdf(695939 bytes) Exhibit B.pdf(155509 bytes) Exhibit C.pdf(44126 bytes) Exhibit D.pdf(188647 bytes) Exhibit E.pdf(140880 bytes) Exhibit F.pdf(236932 bytes) Exhibit G.compressed.pdf(140520 bytes) Exhibit H.pdf(108110 bytes) Exhibit I.pdf(111614 bytes) Exhibit J.pdf(95602 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board**

SAFESIDE TACTICAL, LLC)	
)	
Petitioner,)	
v.)	Processing No. 92060464
)	
CHEYTAC USA, LLC)	Registration No. 4,509,171
)	
Registrant.)	

**REGISTRANT CHEYTAC USA LLC’S RESPONSE IN OPPOSITION TO PETITIONER
SAFESIDE TACTICAL LLC’S MOTION FOR SUMMARY JUDGMENT**

COMES NOW the Registrant, Cheytac USA, LLC (hereinafter “Registrant”), by and through its attorney, and pursuant to TBMP § 528, *et seq.*, files this Response in Opposition to Petitioner’s Motion for Summary Judgment.

STATEMENT OF THE CASE

The evidence that establishes Registrant’s date of first use as June 24, 2011 presents a complete defense to the Petition to Cancel, and in fact makes entry of summary judgment in favor of Registrant and against Petitioner appropriate. Petitioner does not appear to claim otherwise. Instead, Petitioner argues that since Respondent failed to respond to requests, the requests should nevertheless be deemed admitted and summary judgment should be granted in its favor. Respondent was never served by Petitioner with those discovery requests, never received actual notice of those requests and was unaware of their existence.

Given the extraordinary circumstances in this case, Petitioner’s motion urges the Board to ignore the public policy objectives of resolving cases on their merits, to accept a form over substance argument that flies in the face of all established facts, and award Petitioner a windfall victory procured by a procedural technicality that stemmed from the death of Registrant’s attorney.

The facts and evidence in this case demonstrate that Registrant registered the mark SAFESIDE (hereinafter “Registrant’s Mark”) after first using it in commerce approximately eighteen (18) months before Petitioner claims to have used Registrant’s Mark. As such, summary judgment in favor of Registrant and against Petitioner would be appropriate. To the extent Petitioner disputes these facts and Registrant’s claim of use, then there is a genuine issue of material fact in controversy and Petitioner’s motion must fail. Either way, Petitioner’s Motion for Summary Judgment should be denied.

STATEMENT OF FACTS

1. Registrant is the owner of the trademarked name “SAFESIDE” (“Registrant’s Mark”) pursuant to its Application filed on or about February 2, 2013, and the Trademark issued on April 8, 2014 (U.S. Registration No. 4,509,171).

2. Registrant incorrectly stated on its original Application that the first use anywhere and the first use in commerce was December 15, 2012, when in fact the correct date for first use anywhere and first use in commerce is June 24, 2011.

3. Registrant’s misidentification of the first use anywhere and first use in commerce constitutes a good faith error.

4. Registrant’s first use anywhere and first use in commerce of Registrant’s Mark occurred on June 24, 2011 when it issued an invoice for the sale of ammunition magazines bearing Registrant’s Mark, and expressly using Registrant’s Mark on the invoice. A true and correct copy of the June 24, 2011, invoice demonstrating first use is attached hereto as Exhibit “A.”

5. On November 29, 2014, Registrant filed a Section 7 request to correct the mistake and state accurately the date of first use anywhere and the first use in commerce as June 24, 2011, but Registrant’s former counsel did not attach the correct evidence in support thereof.

6. Subsequent to the filing of Registrant's Section 7 request, on or about December 1, 2014, Petitioner filed a Petition to Cancel Registrant's Registration on the grounds of priority of use and the likelihood of confusion pursuant to subdivision (d) of Trademark Act Section 2, which Petition was predicated on the incorrectly identified date of first use anywhere and first use in commerce.

7. On or about December 5, 2014 the Section 7 request was corrected and refiled, and the correct invoice identifying the correct date of first use anywhere and first use in commerce was attached establishing date of first use as June 24, 2011.

8. Petitioner claims it "is the owner of Federal Trademark Application Serial No. 86/201,940 for the mark SAFESIDE TACTICAL (hereinafter "Petitioner's Mark") for use in connection with the following services, namely: 'On-line retail store services featuring firearms and related items; Retail store services featuring firearms and related items,' (hereinafter "Petitioner's Services") covered in International Class 35."

9. As stated in Paragraph 7 of Petitioner's Motion for Summary Judgment, Petitioner's Application claims a date of first use of Petitioner's Mark in connection with services on November 15, 2012, and a date of first use in commerce on December 2, 2012.

10. Petitioner's claimed date of first use of November 15, 2012, and December 2, 2012, is approximately eighteen (18) months after Registrant's first use on June 24, 2011, as evidenced by the attached Exhibit A.

11. Additionally, Petitioner's claimed date of first use is approximately five (5) months after Registrant's second invoice and spreadsheet regarding the use of Registrant's Mark dated May 5, 2012. A true and correct copy of Registrant's May 5, 2012 invoice and May 5, 2012 corresponding spreadsheet are attached hereto as Exhibits "B" and "C" respectively.

12. On or about January 9, 2015, Registrant filed its Answer to the Petition to Cancel.

13. On or about January 15, 2015, Registrant Filed a Motion to Grant Corrected Date of First Use Without Consent pursuant to 37 C.F.R. § 2.175 and TBMP § 514.01 seeking an order correcting the date of first use as June 24, 2011.

14. On or about February 9, 2015, the Board issued an order indicating Registrant's Motion to Grant Corrected Date of First Use was deficient in that it was missing the required fee and declaration in support which had not been submitted along with the Motion by Registrant's former counsel (the "February 9 Order"). The Board granted Registrant 30 days to perfect its request.

15. On or about February 13, 2015, Registrant filed its Reply in Support of Registrant's Motion to Grant Corrected Date of First Use Without Consent.

16. On or about February 15, 2015, Registrant attempted to submit a declaration and fee to the Board in response to the Board's February 9, 2015 Order, but for unknown reasons Registrant's prior attorney, Mr. Romanoff, submitted the fee and declaration in the Trademark File instead of filing it with the Board (and additionally misdated his submission). A true and correct copy of the documents improperly filed in the Trademark File on February 15 are attached hereto as Exhibit "D."

17. Because the documents were filed in the Trademark File and not with the TTAB, Registrant's fee and declaration was returned with notes indicating it was not required. A true and correct copy of the Trademark File notes indicated returned filing is attached hereto as Exhibit "E".

18. On April 4, 2015, attorney for Registrant, Mr. Gerald Romanoff, died.

19. Although Registrant's counsel had attempted to comply with the February 9 Order, on June 5, 2015, the Board entered another order finding that Registrant failed to comply with the February 9 Order and, accordingly, declared that there would be no further consideration to Registrant's Motion to Grant Corrected Date of First Use Without Consent.

20. From July through August, Petitioner claims to have served its First Requests for Production of Documents and Requests for Interrogatory as well as its Motion for Summary Judgment.

21. As evidenced by the exhibits attached to Petitioner's Motion for Summary Judgment, all documents prepared were mailed or emailed to Mr. Romanoff months after his death and burial service.

22. As evidenced by the Declaration of David McCutcheon In Support of Registrant's Opposition to Petitioner's Motion for Summary Judgment, a true and correct copy of which is attached hereto and marked as Exhibit "F," Registrant itself was never served and never received actual notice of any of the discovery documents prepared by Petitioner that it served on Registrant's deceased attorney.

23. In an order dated mailed on November 28, 2015, the Board granted Respondent's November 6, 2015, motion to reopen time to respond to Petitioner's motion for summary judgment with a deadline of thirty (30) days from the November 28, 2015, mailing date.

24. On or about December 21, 2015, Registrant submitted to Petitioner is Responses to Petitioner's First Request for Admissions to Registrant. Registrant first obtained a copy of Petitioner's First Requests for Admissions to Registrant by downloading it as an Exhibit attached to Petitioner's Motion for Summary Judgment located on the Trademark Trial and Appeal Board's website and Electronic Filing System.

ARGUMENT AND CITATION OF AUTHORITY

1. Standard of Review

As there is a strong preference for resolving cases according to their merits, a summary judgment motion can be granted only if both of the following are established by the moving party: (1) there is no genuine dispute as to any material fact; and (2) the movant is entitled to judgment as a matter of law. (Fed. R. Civ. P. § 56(a).)

The court may not weigh evidence to make factual findings, nor may it consider evidence to make credibility determinations. Sensing v. Outback Steakhouse of Fla., LLC, 575 F.3d 145, 163

(1st Cir. 2009). In determining whether a factual dispute warranting trial exists, the court must view the record in the case and the summary judgment submissions in the light most favorable to the nonmovant. Denzler v. Questech, Inc., 80 F.3d 97, 101 (4th Cir. 1996). A reviewing court may not make a determination of any specific facts; rather, the court reviews the papers to determine whether the record reveals a disputed material fact exists. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 (1986). If the reviewing court finds such a material fact exists and is in dispute, the motion for summary judgment must be denied. (*Ibid.*)

In this regard, the Trademark Trial and Appeal Board Manual of Procedure § 528.01 similarly provides as follows:

A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment as a matter of law. This burden is greater than the evidentiary burden at trial. The burden of the moving party may be met by showing that there is an absence of evidence to support the nonmoving party's case.

2. Petitioner's Claim that Respondent's Admissions are Deemed Admitted for Failure to Respond to Discovery Requests Must Be Disregarded.

Petitioner's claim that there are no genuine issues of material fact in this case is not based on the evidence in this case (which evidence actually conflicts with the findings of fact that Petitioner seeks). Rather, it is based on the technical application of the rule that a party failing to respond to requests for admission is deemed to have admitted the requests. (*See* Fed. R. Civ. P. § 36(a)(3).) The success of Petitioner's instant motion depends *entirely* upon this hypertechnical application of law in contravention of the known facts and evidence in this case. If, however, no binding admission occurred, then even a cursory glance at the record reveals that genuine issues of material fact exist and are in dispute which would defeat Petitioner's motion, including Registrant's date of first use, and accordingly the motion should be denied.

Petitioner's claim under F.R.C.P. 36(a)(3) has no effect in this matter for two reasons: (1) Requests for admission may not be served until after the parties' Rule 26(f) discovery conference has occurred; and (2) Petitioner never served Respondent with its discovery requests and Respondent had no actual notice of the requests.

a. There is No Deemed Admission Because No Discovery Conference Occurred.

Registrant's lack of response to Petitioner's request for admissions are not deemed admissions because the parties never had the required discovery conference as set forth in subdivision (f) of Rule 26 of the Federal Rules of Evidence. (Fed. R. Civ. P. §§ 26, subds. (d)(1), (f).) Indeed, unless authorized by court order or by agreement of parties, a party may not seek discovery from any source until the parties have held their discovery plan conference as set forth in subdivision (f) of Rule 26. Accordingly, Petitioner's requests for admission have no effect because Petitioner was not authorized to issue the requests when it did.

There is good reason for requiring a discovery conference prior to the issuance of discovery requests. The entire premise of discovery is to provide a fair opportunity to establish the record of evidence in the case. See, Micro Int'l, Ltd. v. Monolithic Power Sys., 467 F.3d 1355, 1365 (Fed. Cir. 2006). It is through the process of discovery that each party learns the evidentiary basis of the opposing party's case by exchanging information with the opposing party. (*Ibid.*) Without the opportunity for this exchange, it is impossible to establish the record. That is exactly what has happened here.

As noted on page 2 of the Board's Order, mail date of November 28, 2015, Petitioner did not attempt to communicate with Registrant regarding the required discovery conference. Petitioner had a mutual obligation to conduct discovery and, rather than contacting Registrant regarding the outstanding discovery dispute, opted instead to file the instant motion after two weeks. See,

Influence Inc. v. Elaina Zucker, 88 USPQ2d 1859, 1860 (TTAB 2008). Since this conduct does not satisfy the requirements of Rule 26, the discovery requests were improperly served by Petitioner and should be disregarded along with any lack of response.

b. There is No Deemed Admission Because Registrant Never Received the Discovery Requests.

There can be no deemed admission for lack of responding to a request that was never received. Indeed, subdivision (a)(3) of Rule 36 of the Federal Rules of Civil Procedure operates under the critical precondition that the discovery requests in question were both lawfully served and received. The purpose of the Rule is to imply an admission by a party who knowingly fails to respond to the discovery request under those conditions. The purpose of the rule, however, is not to grant a windfall victory by procedural technicality to a party who improperly submits requests, fails to verify whether the requests were received or what the dispute is regarding, and then rushes to file a dispositive motion with the hope of avoiding the ultimate merits of the case.

3. Petitioner's Motion Must be Denied Because Genuine Disputes of Material Fact Exist In This Case.

The primary issue in the Petition to Cancel is whether Registrant's date of first use anywhere and first use in commerce predates Petitioner's dates of first use. Petitioner claims a date of first use of December 2, 2015. Registrant, however, has a claimed date of first use of June 24, 2011. This fact by itself is proof that Registrant has provided evidence that the date of its first use predates Petitioner's by approximately 18 months.

It is important to note that Registrant was in the process of establishing this fact by filings its Section 7 request to correct the date of first use to June 24, 2011, prior to the time the Petition to Cancel was filed and prior to the death of Registrant's attorney. Furthermore, this fact is material since its existence constitutes a complete defense to the Petition to Cancel.

Moreover, the existence of this fact is directly contrary to Petitioner's claim that "there is no dispute as to the dates of first use and dates of first use in commerce as to the respective trademarks." (Petitioner's Motion for Summary Judgment at p. 5.) Petitioner has only two choices: either it agrees that fact proves Registrant's claim predates Petitioner's or Petitioner disputes that fact. Either way, viewing the evidence in the light most favorable to Registrant, Petitioner's motion for summary judgment must be denied.

Ultimately, Registrant presents significant evidence that satisfies the clear and convincing evidence standard in support of its claim that Registrant's date of first use is June 24, 2011, that it's date of first use significantly predates Petitioner's December 2, 2012 claimed date of first use, and that Registrant's use was continuous from its June 24, 2011 date of first use through the present, including Petitioner's date of first use on December 2, 2012. The evidence in support of the foregoing claims consists of the following documents and evidence:

1. As evidence of its first use, Registrant hereby provides a true and correct copy of its invoice dated June 24, 2011, for the sale of its goods and services under its registered Mark. (Exhibit "A").

2. As further evidence of first and continuing use that predates Petitioner's date of first use, Registrant hereby provides a true and correct copy of a letter from the U.S. Bureau of Alcohol, Tobacco, Firearms, and Explosives dated December 19, 2011, a true and correct copy of which is attached hereto and marked as Exhibit "G," indicating that Registrant was "seeking a marking variance to manufacture and mark . . . SAFESIDE bolt-action receivers on behalf of Cheytac USA, LLC."

3. As evidence of continuing use that predates Petitioner's date of first use, Registrant hereby provides a true and correct second invoice dated May 9, 2012, and corresponding spreadsheet

also for the sale of its goods and services under its registered Mark. (Exhibits “B,” and “C”) Both invoices and the spreadsheet indicate use of Registrant’s Mark that predates Petitioner’s use of its Mark by 18 months and 5 months, respectively.

4. As further evidence of continuing use that predates Petitioner’s date of first use, Registrant hereby provides a true and correct copy of an email dated November 28, 2012, from Registrant’s employee regarding the negotiation and sale of Registrant’s products utilizing the Mark, specifically for a “Safeside Tactical Engagement Rifle.” (Exhibit “H”)

5. As further evidence of continuing use that predates Petitioner’s date of first use, Registrant hereby provides a true and correct copy of an email dated November 30, 2012, from Registrant’s employee to Stiller Precision regarding the negotiation and sale of items including products described in the email as “2 Safeside.” (Exhibit “I”)

6. As further evidence of continuing use, Registrant hereby provides a true and correct copy of an email dated April 30, 2013, from Registrant’s employee to Stiller Precision regarding the negotiation and sale of items including products noted as “[t]he 10 Safesides are at nitride now and I expect them to be ready in about 3 weeks.” (Exhibit “J”)

7. Finally, as evidence in support of its first and continuous use, Registrant hereby submits and incorporates by reference the attached Declaration of David McCutcheon in support, Exhibit F, verifying each of the above exhibits and stating under penalty of perjury that Registrant has actively marketed and/or sold its goods and services under its Registered Mark from June 24, 2011, to the present day.

The evidence that Registrant has produced to establish its date of first use of the Mark as June 24, 2011, is a complete defense to Petitioner’s Petition to Cancel. Petitioner may disagree. But even if it does, as stated before, a genuine issue of material fact exists and its Motion for Summary

Judgment must be denied.

CONCLUSION

Registrant's lack of response to Petitioner's Request for Admissions must be disregarded because the discovery requests Petitioner submitted were in violation of Rule 26 of the Federal Rules of Civil Procedure and because Registrant was never served with the requests and was unaware of their existence.

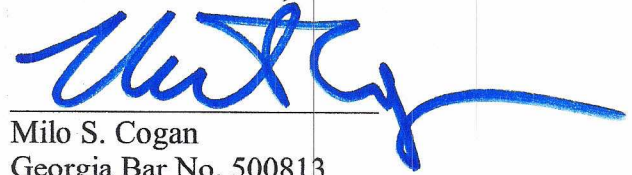
Moreover, Registrant robustly denies any claims or suggestions by Petitioner that its date of first use occurred on some date other than June 24, 2011, and has provided evidence of a date of first use on or about June 24, 2011. Registrant's claimed date of first use predates Petitioner's December 2, 2012, date of first use by approximately 18 months.

When determining whether a factual dispute warranting trial exists, the court must view the record in the case and the summary judgment submissions in the light most favorable to the nonmovant. Denzler v. Questech, Inc., 80 F.3d 97, 101 (4th Cir. 1996).) Accordingly, Petitioner's motion must be denied because the evidence, viewed favorably to Registrant, indicates a genuine issue of material fact exists as to whether Registrant's date of first use predates Petitioner's date of first use.

Notwithstanding the above, ordinarily, the critical issue in determining Petitioner's Motion for Summary Judgment is only whether a genuine disputed issue of material fact exists, not how many disputed facts exist or the relative strength or weakness of each of those facts. *See, supra*, Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 (1986). Registrant has demonstrated that a genuine issue of material fact exists since the Registrant has presented evidence that directly contradicts Petitioner's claim of when Registrant's Registered Mark was first used. Accordingly, for the foregoing reasons, Petitioner's Motion for Summary Judgment should be denied.

Respectfully submitted, this 22nd day of December, 2015.

FISHERBROYLES, LLP



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Georgia Bar No. 500813

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(404) 935-0271 (fax)
Milo.cogan@fisherbroyles.com

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SAFESIDE TACTICAL, LLC)	
)	
Petitioner,)	
v.)	Processing No. 92060464
)	
CHEYTAC USA, LLC)	Registration No. 4,509,171
)	
Registrant.)	
)	
)	

/s/Milo S. Cogan
Milo S. Cogan

EXHIBIT “A”



Receipt

CheyTac USA

Distance-Power-Accuracy

541 Hazel Ave, Nashville, GA 31639
Phone 229.686.3219 Fax 1.888.519.5242

INVOICE: MFJUNE2011
DATE: JUNE 24, 2011

EXPIRATION DATE: JULY 2012

TO Name: Mark Fields
Address: 3116 Gideon Court
Waldorf, MD 20602
Fax:
Email: mark.t.fields@gmail.com

SALESPERSON	JOB	SHIPPING METHOD	SHIPPING TERMS	DELIVERY DATE	PAYMENT TERMS	DUE DATE
Joe	MF	Best	NA	NA	Paid in Full	Expected

QTY	ITEM #	DESCRIPTION	UNIT PRICE	DISCOUNT	LINE TOTAL
1	Rifle	.308 Win. Mag. Custom "Safeside"	\$6,000.00	\$0.00	\$6,000.00
			SUBTOTAL	\$0.00	\$6,000.00
			SHIPPING (EST)		N/A
			TOTAL		\$6,000.00

THANK YOU FOR YOUR BUSINESS!

EXHIBIT “B”

Stiller's Precision Firearms LLC

Invoice

118 Regency Drive
Wylie, TX 75098

Phone #: 972-429-5000
Fax #: 972-941-8884

E-mail: stiller@viperactions.com
Web Site: viperactions.com

Date	Invoice #
5/9/2012	2332

Bill To
CheyTac LLC Darryl Miller 1421 Forest Way Nashville GA 31639

Ship To

P.O. Number	Terms	FFL #	Ship	Via	F.O.B.	Project
			5/9/2012			
Quantity	Item Code	Description	Price Each	Serial #	Amount	
10	CheyTac - 1.6 408 Rep R	CheyTac PTAC 408 extreme length bolt action receiver, 1.60" diameter, .645" boltface, right bolt, right port, repeater, black oxide finish	925.00		9,250.00T	
2	CheyTac - Lap Xt Rep R	CheyTac Perses extreme length bolt action receiver, lapua boltface, right bolt, right port, repeater	875.00		1,750.00T	
4	CheyTac - Mag Lg Rep...	CheyTac Vidar long bolt action receiver, mag boltface, right bolt, right port, repeater	825.00		3,300.00T	
4	CheyTac - 308 Sh Rep R	CheyTac Safeside short bolt action receiver, 308 boltface, right bolt, right port, repeater	825.00		3,300.00T	
		**** 50% Deposit for OEM actions - \$8800.00 **** Out-of-state sale, exempt from sales tax	0.00%		0.00	

EXHIBIT “C”

Vendor
Stiller's Precision
Firearms, LLC
 118 Regency Drive
 Wylie, TX 75098

Phone / Fax / Email
 Jerry Stiller
 Russ Rosene
 PH: 972-429-5000
 Fax: 972-941-8884
 Email:
 stiller@viperactions.com

Notes:
 FFL # 5-75-085-07-6K-41806 Expires 10/01/2016
 Website: www.viperactions.com

Date	Order No.	QTY	Item No.	Description	Price Each
5/9/12	Inv. 2332	10	CheyTac - 1.6 408 Rep R	CheyTac PTAC 408 extreme length bolt action receiver, 1.60" diameter, .645" boltface, right bolt, right port, repeater, black oxide finish	\$925.00
		2	CheyTac - Lap Xt Rep R	CheyTac Perses extreme length bolt action receiver, lapuaboltface, right bolt, right port, repeater	\$875.00
		4	CheyTac - Mag Lg Rep	CheyTac Vidar long bolt action receiver, mag boltface, right bolt, right port, repeater	\$825.00
		4	CheyTac - 308 Sh Rep R	CheyTac Safeside short bolt action receiver, 308 boltface, right bolt, right port, repeater	\$825.00
		1	Wire Transfe	Fee From American Nation	\$25.00

;

Subtototal	Subtotal of Purchase	Tax	Total	Method of Payment
\$9,250.00	\$17,625.00	\$0.00	\$17,625.00	50% Deposit for OEM Actions - \$8,825.00

\$1,750.00

\$3,300.00

\$3,300.00

\$25.00

EXHIBIT “D”

SAFESIDE FEE
AND
DECLARATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The Trademark Trial and Appeal Board

In the matter of U.S. Registration No. 4,509,171

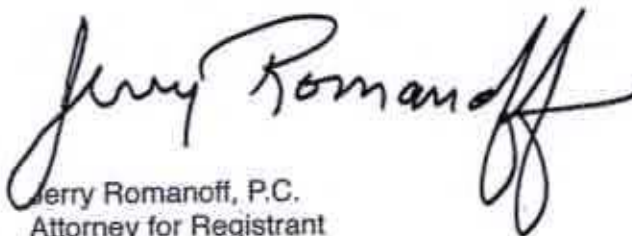
For the mark SAFESIDE

Registered on the principal registration on April 8, 2014

This is in response to your request for the fee and a Declaration in the above matter.

Both the fee and Declaration are enclosed.

Respectfully submitted this 15th day of March 2015



Jerry Romanoff, P.C.
Attorney for Registrant

Jerry Romanoff, Esq.
4 Oceanview Court
Long Beach, New York 11561

Tel: 516-889-4808
Cell: 914-715-0444
jerry@trademark1attorney.com

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Credit Card Payment Form

(Do not submit this form electronically via EFS-Web)
Please Read Instructions before Completing this Form

Credit Card Information

Credit Card Type: ☐ Visa ☐ MasterCard ☒ American Express ☐ Discover

Credit Card Account #: 3767 430287 54001

Credit Card Expiration Date (mm/yyyy): 10/2019

Name as it Appears on Credit Card: GERALD ROMANOFF

Payment Amount (US Dollars): \$

Cardholder Signature: Gerald Romanoff

Date (mm/dd/yyyy):

2/15/2015

The USPTO does not accept an s-signature (37 CFR 1.4(e)) on credit card payment forms.

Refund Policy: The USPTO may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The USPTO will not refund amounts of \$25.00 or less unless a refund is specifically requested and will not notify the payor of such amounts (37 CFR 1.26). Refund of a fee paid by credit card will be issued as a credit to the credit card account to which the fee was charged.

Maximum Daily Limit: There is a \$49,999.99 daily limit per credit card account. There is no daily limit for debit cards.

Credit Card Billing Address

Street Address 1: 4 OCEANVIEW COURT

Street Address 2:

City: LONG BEACH

State/Province: New York

Zip/Postal Code: 11561

Country: USA

Daytime Phone #: 914-715-0444

Fax #: 516-859-4193

Request and Payment Information

Description of Request and Payment Information:

<input type="checkbox"/> Patent Fee	<input type="checkbox"/> Patent Maintenance Fee	<input checked="" type="checkbox"/> Trademark Fee	<input type="checkbox"/> Other Fee
Application No.	Application No.	Application No.	IDON Customer No.
Patent No.	Patent No.	Registration No. 4509171	
Attorney Docket No.		Identify or Describe Mark SAFE610C AMENDMENT	

If the cardholder includes a credit card number on any form or document other than the Credit Card Payment Form or submits this form electronically via EFS-Web, the United States Patent and Trademark Office will not be liable in the event that the credit card number becomes public knowledge.

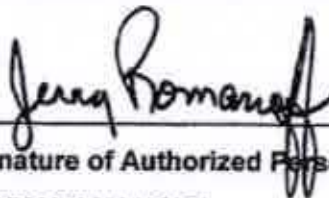
JERRY ROMANOFF, P.C.
Attorney-at Law

U.S. REGISTRATION NUMBER 4509171

REGISTRANT: CHEYTAC USA. LLC

DECLARATION UNDER 37 C.F.R. SEC. 2.20

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statement may jeopardize the validity of the document, declares that he is properly authorized to execute this document on behalf of the owner, and all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

A handwritten signature in black ink, appearing to read "Jerry Romanoff", is written over a horizontal line.

Signature of Authorized Person

JERRY ROMANOFF

FEB. 15, 2015

EXHIBIT “E”

NOTE TO THE FILE

SERIAL NUMBER: 85839213
DATE: 02/20/2015
NAME: tgray

NOTE:

Searched:

☐ Google
☐ Lexis/Nexis
☐ OneLook
☐ Wikipedia
☐ Acronym Finder
☐ Other:
☐ Discussed ID with:
☐ Senior Atty
☐ Managing Atty
☐ Protest evidence reviewed

Checked:

☐ Geographic significance
☐ Surname
☐ Translation
☐ ID with ID/CLASS mailbox

Discussed Geo. Sig. with:

☐ Senior Atty
☐ Managing Atty

☐ Checked list of approved Canadian attorneys and agents

Discussed file with

Attorney/Applicant via:

☒ Phone
☐ email
☐ Requested Law Library search
☐ Left message with Attorney/Applicant
☐ Issued Examiner's Amendment and entered changes in TRADEUPS
☐ Added design code in TRADEUPS
☐ Description of the mark
☐ Translation statement
☐ Re-imagined standard character drawing
☐ Negative translation statement
☐ Consent of living individual
☐ Contacted TM MADRID ID/CLASS about misclassified definite ID
☐ Changed TRADEUPS to:

☒ OTHER: The Communication filed on 2/18/15 will be noted. However, the payment of \$100 is not a requirement and will be refunded in due course.

EXHIBIT “F”

CheyTac USA, LLC, sold its first .308 rifle using the Safeside in June of 2011. The June 24, 2011, invoice attached as Exhibit A to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of an invoice sent for the sale of a custom .308 win mag rifle bearing the mark SAFESIDE for which occurred in June 2011.

3.

In December of 2011, CheyTac USA, LLC, received confirmation that the variance submitted through the U.S. Bureau of Alcohol, Tobacco, Firearms, and Explosives had been approved. The letter dated December 19, 2011, from the U.S. Bureau of Alcohol, Tobacco, Firearms, and Explosives attached as Exhibit G to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of a letter I received from the ATF regarding a requested variance on behalf of CheyTac USA, LLC, for the mark SAFESIDE for which occurred in December 2011. the sale of its Safeside branded rifles and rifle systems.

4.

Once the variance was approved by the ATF, CheyTac USA, LLC continued to promote, market, and sell rifles and rifle systems under the Safeside brand. Specifically, in May of 2012, CheyTac USA, LLC purchased receivers from Stiller actions. The May 9, 2012, invoice attached as Exhibit B to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of an invoice sent for the sale of a custom .308 short bolt action receiver bearing the mark SAFESIDE for which occurred in May 2012.

5.

The May 9, 2012, spreadsheet corresponding to the invoice of the same date, attached as Exhibit C to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of an invoice sent for the sale of a custom .308 short bolt action receiver bearing the mark SAFESIDE for which occurred in May 2012.

//

6.

In November of 2012, in response to our continued sales and promotion of the Safeside brand, CheyTac USA, LLC sent a quote to a customer regarding its Safeside branded product. The email dated November 28, 2012, from Registrant's employee regarding the negotiation and sale of Registrant's products utilizing its Mark, specifically for "Safeside Tactical Engagement Rifle," attached as Exhibit H to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of said email.

7.

Later, in November of 2012, CheyTac USA, LLC negotiated with Stiller Precision for the purchase of new receivers bearing the Safeside mark. The email dated November 30, 2012, from Registrant's employee to Stiller Precision regarding the negotiation and sale of items including products described as "2 Safeside," attached as Exhibit I to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of said email.

8.

In April of 2013, new actions bearing the Safeside brand were being manufactured by Stiller Precision for CheyTac USA, LLC, and further communications were taking place with respect to this prospective commercial transaction. The email dated April 30, 2013, from Registrant's employee to Stiller Precision regarding the negotiation and sale of items including products noted as "[t]he 10 Safesides are at nitride now and I expect them to be ready in about 3 weeks," attached as Exhibit J to Registrant's Second Motion to Grant Corrected Date of First Use Without Consent is a true and correct copy of said email.

//

9.

The brand Safeside has personal meaning to me and references back to my time spent in the military while stationed in Iraq. Although CheyTac USA, LLC has not sold many of the rifle systems, I am proud of the brand and the product.

10.

CheyTac USA, LLC has not abandoned the Mark since its first use in 2011, currently has Safeside branded inventory in stock, and is ready, willing, and able to complete the continued sales of the Safeside branded products as of the date of this declaration.

11.

When I applied for the Safeside trademark, I am informed and believe that my attorney performed all possible checks and "due diligence" necessary through the Trademark Office and was granted the trademark to use the Safeside mark accordingly.

Executed at Nashville, Georgia

Date: December 17, 2015 By: David R. McCutcheon
David McCutcheon, President

EXHIBIT “G”



U.S. Department of Justice

Bureau of Alcohol, Tobacco,
Firearms and Explosives

Martinsburg, West Virginia 25405

www.atf.gov

DEC 19 2011

903050:ADM
3311/2012-213
5-75-41806

Jerry Stiller
Stiller's Precision Firearms, LLC
2405 Country Meadow Lane
Wylie, Texas 75098

Re: Stiller's Precision Firearms, LLC, FFL#: 5-75-41806
Cheytac USA, LLC, FFL#: 1-58-07415

Dear Mr. Stiller:

This letter is in response to your correspondence received December 6, 2011, to the Bureau of Alcohol, Tobacco, Firearms and Explosives (ATF), Firearms Technology Branch, in which you request a marking variance from the provisions of 27 CFR Section 478.92(a)(1). The cited section requires, in part, that firearms manufactured by a licensed manufacturer must bear certain identification markings that include the name, city, and state of the manufacturer.

In your correspondence, you indicate that you are seeking a marking variance to manufacture and mark Model PTAC, PERSES, VIDAR, and SAFESIDE bolt-action receivers on behalf of Cheytac USA, LLC. Included in your correspondence, you submitted the following identifying information and drawings to indicate the required markings to be placed on the Model PTAC, PERSES, VIDAR, and SAFESIDE bolt-action receivers:

Serial Number: PTAC: 37600001
PERSES: 43500001
VIDAR: 82000001
SAFESIDE: 40700001

Chy 8
Lap
Long
Sh4

Model: PTAC, PERSES, VIDAR, or SAFESIDE

CHEYTAC USA LLC NASHVILLE, GA

EXHIBIT “H”

Wiley

From: Rich Mulder <rich@cheytac.com>
Sent: Wednesday, November 28, 2012 1:01 PM
To: ~~thomson@cityofelsmere.com~~
Cc: darryl@cheytac.com
Subject: Cheytac .308 Quote
Attachments: ~~Tim Thomas ELSMERE PD.pdf~~

Tim,
Here is the quote on our Safeside Tactical Engagement Rifle .308 (dealer cost for Law Enforcement agencies). Some areas of discussion are; suppressor needs, weapons case, night vision capability and quantity of magazines. All of which, we can add to your quote as you consider your options. If you have suppressor needs (recommend the AAC MK13-SD at a cost of \$1,965) we will have to discuss this with you in order to set the rifle up properly. Our weapons cases come already formed for your weapon and components at a cost of \$675. You have additional magazine options in loads of 5 or 10 rounds. If night vision is required, we recommend the M2124. Please feel free to contact me or Darryl in the CC block. VR

Rich Mulder
rich@cheytac.com
229-686-3219

EXHIBIT “I”

Wiley

From: Stillers Precision <stiller@viperactions.com>
Sent: Friday, November 30, 2012 1:54 PM
To: Darryl
Subject: Re: CheyTac USA M300 Intervention

Hi Darryl,

Same serial numbers as the PTAC's or a new scheme?

Regards,

Russ

On 11/30/2012 11:40 AM, Darryl wrote:

> That is correct, but if I could? I would like to make it 15 M300, and
> 3 Perses and 2 Safeside for a total of 20?

>

> Thank you,

>

> Darryl

>

>

> -----Original Message-----

> From: Stillers Precision [<mailto:stiller@viperactions.com>]

> Sent: Friday, November 30, 2012 11:58 AM

> To: Darryl

> Subject: Re: CheyTac USA M300 Intervention

>

> Hi Darryl,

>

> Are you looking at the 20 we talked about?

>

> Regards,

>

> Russ

>

> On 11/30/2012 10:46 AM, Darryl wrote:

>> Good Morning Russ/Jerry,

>>

>>

>> As we spoke earlier, we would like to move forward with the new action:

>>

>> We would like to have a new variance with you for our new model M300

>> Intervention utilizing your Tactical 408 (1.45 O.D.)

>>

>> We would like for the left side to state:

>>

>> M300 INTERVENTION

EXHIBIT “J”

Wiley

From: Stillers Precision <stiller@viperactions.com>
Sent: Tuesday, April 30, 2013 11:49 AM
To: Darryl
Subject: Re: CheyTac USA, LLC

Hi Darryl,

We have 13 Perses in assembly QC now, I expect they will be ready to ship within a week. The 10 Safesides are at nitride now and I expect to have them back and ready in about 3 weeks.

I will check on the remaining M300 & Vidars and let you an ETA.

When you send payments can you send me a copy or payment amount and date? I do not have access to the account and I want to have you properly credited for payments.

Also - were you going to send us some 408 brass to ensure function on your actions?

Regards,

Russ

On 4/30/2013 7:34 AM, Darryl wrote:

> Good Morning Gentlemen!

>

> Just checking on our order?

>

> Thank You,

>

> Darryl P. Miller

> CheyTac USA, LLC

> 229-686-3219

>

>

>